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In re Application of:	:	
DEBRUYNE, Kristine, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/536,714	:	37 CFR 1.47(a)
PCT No.: PCT/AU2003/001584	:	
International Filing Date: 28 November 2003	:	
Priority Date: 29 November 2002	:	
Attorney's Docket No.: COCH-0149-US1	:	
For: COCHLEAR IMPLANT DRUG	:	
DELIVERY DEVICE	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a) At Least One Joint Inventor Available" filed 04 May 2006. Applicants have paid the required petition fee.

BACKGROUND

On 28 November 2003, applicants filed international application PCT/AU2003/001584. The international application claimed a priority date of 29 November 2002 and it designated the United States. On 17 June 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 29 May 2005.

On 27 May 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 04 October 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date was required.

On 04 May 2006, applicants filed a response to the Notification Of Missing Requirements (with required five-month extension fee). The submission includes the required surcharge payment and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Kristine DEBRUYNE, whom applicants assert has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the required petition fee, and the petition expressly states the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, the declaration materials filed by applicants include three copies of a declaration form that identifies four of the inventors and indicates that additional inventors are being named on attached sheet(s) (the declaration form does not indicate how many sheets are attached); each of these sheets is executed by one of the inventors listed thereon. Applicants have also submitted two copies of a page identified as "Page 2 of 2." These pages list the remaining two inventors of record, and each of these sheets is executed by one of the inventors listed thereon. This five-page declaration submission appears to be a compilation of multiple copies of a two-page declaration, and as such is not acceptable under 37 CFR 1.497 (See MPEP § 201.03(II)(B): "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.") Applicants must submit complete declarations acceptable under 37 CFR 1.497 executed by each of the signing inventors and containing an unsigned signature block for the non-signing inventor. Until the required declarations are submitted, item (3) is not satisfied.

Regarding item (4), MPEP section 409.03(d) states that "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants have provided statements from Jayne ANDREWS and Kate KRALJ, with supporting documents, providing a firsthand description of the efforts made to obtain the inventor's signature. These materials provide the required showing that the non-signing inventor has been provided (via email) with a request for signature and a copy of the application papers, that the inventor orally confirmed receipt of these documents, and that the inventor expressly stated that she would not execute the application documents. Item (4) is satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy item (3) of a grantable petition, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459